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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,309	09/28/2001	Dirk Kranendonk	25098A	5049
22889	7590	10/15/2003	EXAMINER	
OWENS CORNING			TORRES VELAZQUEZ, NORCA LIZ	
2790 COLUMBUS ROAD			ART UNIT	PAPER NUMBER
GRANVILLE, OH 43023			1771	

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,309

Applicant(s)

KRANENDONK, DIRK

Examiner

Norca L. Torres-Velazquez

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>092203</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. Applicant's arguments filed on July 21, 2003 have been fully considered but they are not persuasive.

a. The rejection of claim 8 under 35 U.S.C. 112, first paragraph, has been withdrawn in view of Applicant's amendment.

However, claim 8 is now rejected under 35 U.S.C. 112, second paragraph as being indefinite because the Applicant has not provided copy of procedure used to measure the water vapor transmission rate by the DIN Standard 52615.

b. Claim 13 remains rejected because it contains the trademark/trade name Papermatch. While the Applicant argues that the use of the trademark Papermatch® in connection with the word "dispersion" is proper, it is still noted that the Papermatch® trademark/trade name is used to identify/describe a dispersion of ground calcium carbonate and ground titanium dioxide in high density polyethylene and, accordingly, the identification/description is still indefinite.

c. The Applicant further argues that Gundberg provides a nonwoven with a netting coating and thus the product it provides is not a regular paintable surface structure. Further, the Applicant argues that the reference is directed to insulation.

It is noted that the term "regular" included in claim 1 is not defined in the Specification. The surface taught by the Gundberg reference provides a structure including fiber base layer [mat] and a thermoplastic polymer coating. The thermoplastic polymer coating is applied in the form of a netting coating that is then melted and the polymer melt is distributed on the surface of the base layer. (Refer to column 2, lines 12-

18) Therefore, it is the Examiner position that the Gundberg reference does provide the claimed structure. With regards to the surface being "paintable", it is noted that the reference teaches the use of thermoplastic polymer materials such as polyethylene and polypropylene (refer to Column 3, lines 12-14), which are the same compounds used in the present invention.

d. The Applicant noted that the Examiner had mistakenly submitted the wrong reference for the rejection of Claim 2 over Gundberg in view of LAST.

Applicant's observation is correct and the reference was wrongly cited. The LAST reference is a GB patent not a US patent. The correct citation is LAST (GB 1,463,671), which is included herein.

The rejection of claim 2 over Gundberg in view of Last has been withdrawn in view of Applicant's arguments. There is not motivation to apply a corona discharge treatment to Gundberg's fiber element since Gundberg does not teach attaching or adding additional layers to it.

e. The Applicant further argues that it would not be obvious to combine the Gundberg reference and the Penz et al. or Melber references because the fibrous thermoplastic netting layer adhered to a mineral fiber base layer in Gundberg is used as an insulator, not a polymeric wall covering.

Applicant's arguments have been noted, however, it is the Examiner's position that the Gundberg reference provides the present structure. While it is correct that the Gundberg invention is used as an insulator, the reference does not preclude its use to other applications. (Refer to column 1, lines 17-18). It is noted that acoustic insulation

materials are known to be used as wall panels (i.e. as in wall partitions), therefore, the use of fillers to provide the paint enhancement characteristics of the PENZ reference and the opacifying characteristics would be desirable.

f. It is also noted that confirmation of election to prosecute group I, Claims 1-13 is missing on Applicant's response.

g. The Information Disclosure Statement submitted by Applicant on September 22, 2003 has been considered. It is noted that the Melber reference (US 4,898,892) has been cited by the Examiner on the previous action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 contains the trademark/trade name Papermatch. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a

Art Unit: 1771

dispersion of ground calcium carbonate and ground titanium dioxide in high density polyethylene and, accordingly, the identification/description is indefinite.

4. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites a wall covering material "requiring less paint consumption", because this limitation implies a comparison and it is not clear to what the invention is being compared, i.e., requires less paint than what? Presumably it's being compared to another wall covering, but it's not clear what type, i.e. how the comparative wall covering differs from the inventive wall covering.

5. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "regular" in claim 1 is a relative term which renders the claim indefinite. The term "regular" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Is Applicant using the term "regular" to refer to a flat surface? If it is a flat surface, then, what parameter is using to compare it to other surfaces?

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, 3-5 and 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by GUNDBERG et al. (US 6,203,646).

GUNDBERG et al. discloses a method of producing a mineral fiber element comprising a mineral fiber base layer having a surface coating in the form of a fibrous netting formed of a thermoplastic polymer material wherein such a surface coating is provided on at least a part of the surface of the base layer, wherein the surface coating is formed by heating a thermoplastic polymer material so as to melt it and distributing the polymer melt obtained in the form of fibers and/or filaments on the surface of the base layer and cooling it to form a solid layer. (Abstract)

The mineral base layer may have any form and typically it has the form of an endless web, a web, a mat or a sheet. (Column 3, lines 39-40) Therefore, the mineral base layer of GUNDBERG et al. equates to the claimed non-woven fiber tissue or mat of the present invention. Further, GUNDBERG et al. also anticipates the limitations of claim 11 since it teaches the use of mineral fibers. (Above) Since the material is the same, it would inherently meet the limitation "requiring less paint..."

Art Unit: 1771

With regards to claims 3, 4 and 5, GUNDBERG et al. teaches the use of a surface coating with a surface weight of from 2 g/m² to 50 g/m². It also teaches the use of thermoplastic polymer materials such as polyethylene and polypropylene. (Column 3, lines 12-35)

With regards to claim 12, the reference teaches that in order to impart sufficient strength to the non-woven material, it should have a surface weight of at least about 20 g/m². (Column 1, lines 47-51)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GUNBERG et al.

It is noted that GUNBERG et al. is silent with respect to the claimed surface tension of the coating surface. However, it is reasonable to presume that the claimed surface tension is inherent to the invention of GUNBERG et al. Support for said presumption is found in the use of the same starting materials (i.e. fiber matt and thermoplastic polymer coating), like processes of making the articles (i.e., melting polymer of the matt), and the production of similar end-products (i.e., reinforced mineral fiber materials, etc...). The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the presently claimed function of surface tension would obviously have been provided as a result of the inventive corona discharge treatment taught by LAST's reference. *Note In re Best*, 195 USPQ 433.

Art Unit: 1771

10. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over GUNBERG et al. as applied to claims 1, 3-5 and 11-12 above, and further in view of PENZ et al. (US 5,888,913).

GUNBERG et al. fails to teach the use of mineral filler in the thermoplastic polymer coating.

PENZ et al. discloses glass matt reinforced thermoplastic and one of the object of their invention is to find glass matt reinforced thermoplastics with no insert visibility and that on the painted part satisfactory paint adhesion on the glass matt reinforcement thermoplastic surface is obtained without great expenditure. The reference teaches the addition of fine-particle, mineral fillers to enhance the paint adhesion. (Column 1, lines 64 – Column 2, lines 1-10)

The reference further teaches adding mineral fillers such as talc, chalk and barium sulfate at concentrations from 2 to 60% by weight to the thermoplastics. (Column 3, lines 14-18)

Since both GUNBERG et al. and PENZ et al. are from the same field of endeavor, the purpose disclosed by PENZ et al. would have been recognized in the pertinent art of GUNBERG et al.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the thermoplastic polymer coating and provide it with mineral fillers with the motivation of obtaining a satisfactory paint adhesion on the glass matt reinforced thermoplastics as disclosed by GUNBERG et al. (Above).

11. Claims 9, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over GUNBERG et al. as applied to claims 1, 3-5 and 11-12 above, and further in view of MELBER et al. (US 4,898,892).

GUNBERG et al. fails to teach the use of an opacifying agent such as titanium dioxide in the thermoplastic polymer coating.

MELBER et al. discloses a method for making an opaque coating comprising combining a film forming coating binder and a composite opacifier. The reference teaches the use of inorganic opacifier materials such as titanium dioxide and calcium carbonate. (Column 1, lines 36-45) On Table III, the reference teaches how the film thickness and volume of opacifier is necessary for 94% hiding. (Column 17, lines 6-23). With regards to claim 13, it is known that the trademark product Papermatch is a dispersion of ground calcium carbonate and ground titanium dioxide in high density polyethylene and the prior art of reference teaches the use of these components, the ratio or ranges of concentration of these would be an obvious cause-effective variable that will depend on the intended refractive index of the opacifying component. (Refer to claims 1 and 3)

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the coating material to contain titanium dioxide with the motivation of providing the coating with "hiding" as disclosed by MELBER et al. (Above and also refer to column 2, lines 24-26).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1771

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

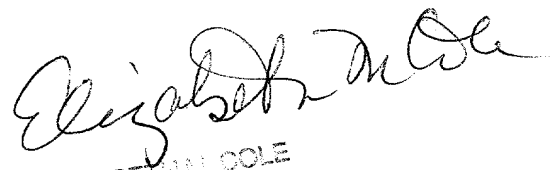
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 703-306-5714. The examiner can normally be reached on Monday-Thursday 8:00-4:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

NLT

October 7, 2003


ELIZABETH M. COLE
PRIMARY EXAMINER